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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/243,016	02/02/1999	DIRK LENZ	BEIERSDORF54	1839

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EXAMINER

GHALI, ISIS A D

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 09/04/2002

29

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/243,016

Applicant(s)

Lenz et al.

Examiner

Isis Ghali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 9, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, and 5-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, and 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

The receipt is acknowledged of applicants' request for extension of time, preliminary amendment E, and request under 1.114, all filed 7/09/2002.

Claim 2 had been canceled by previous amendment C, in paper No. 21 filed 1/17/2002, and claim 4 has been canceled by amendment E, paper No. 28. Thus, pending claims are 1, 3, 5-13.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/09/2002 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3, 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 89/04649 ('649), by itself or in combination with US 3,908,645 ('645).

WO '649 discloses an occlusive opaque eye patch comprising:

- 1) an outer polymeric foam layer,
- 2) intermediate foam layer,
- 3) inner pressure sensitive adhesive layer, and
- 4) inner member of black felt which is dimensioned so that it can be placed concentrically within the edges of the adhesive layer so that peripheral portion of the adhesive is exposed to be attached to the skin. The adhesive portion is secured with a

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cover that can be peeled off at use. See page 1, lines 3-6; page 5, lines 1-12, 23-30; page 6, lines 1-3; page 9, lines 12-17.

WO '649 does not disclose the foam material as polyurethane or the method of making the foam.

US '645 discloses an eye bandage comprising a layer of polyurethane foam, covered with non-woven web material of polyester on one side and pressure sensitive adhesive layer on the other side. The pressure sensitive adhesive is covered with a release liner. The reference disclosed foaming the polyurethane between two liners and the foam is then split or slit through its center producing two identical thinner sheets of foam having minimum reflectance (opaque). See abstract; col.1, lines 44-58; col.2, lines 30-43; col.3, lines 31-44; col.4, lines 3-4, 35-50; col.6, lines 9-16.

Applicants failed to show criticality or superior and unexpected results in the sequence of arranging the layers or having the three layers made of foam. Felt is also a kind of foam, is not solid or compact.

Accordingly, it would have been obvious for one having ordinary skill in the art at the time of the invention to produce an occlusive patch consisting of three layers of foam material, and use the polyurethane of US '645, motivated by the teaching of US '645 that the two layers of foam provide very low reflectance, with reasonable expectation of success of the delivered patch as an ophthalmic light occlusive patch.

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4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4,538,603 and US 5,844,013 disclosed dressing or patches comprising foam layers of polyurethane and methods of their making.

Response to Arguments

5. Applicant's arguments filed 7/09/2002 have been fully considered but they are not persuasive.

Applicants are traversing the rejection of claims 1, 3, 5-13 as being unpatentable over WO '649 by itself or in combination with US '645 by arguing that WO '649 does not teach but one foam layer, and only the outer layer can be opaque. US '645 teaches only one foam layer.

In response to the above arguments, the examiner position is that: WO '649 teaches clearly 2 foam layers and felt black layer (page 9, lines 10-17). Felt is not solid and it can be foam. Applicants failed to provide superior and unexpected results to show the criticality in the sequence of the arrangement of the layers as claimed. US '645 disclosed two layers of foam and is relied upon for teaching the foam as polyurethane. Thus, one having ordinary skill in the art at the time of the invention would have been motivated to produce an occlusive patch consisting of three layers of foam material, and use the polyurethane of US '645, motivated by the teaching of US

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'645 that the two layers of foam provide very low reflectance, with reasonable expectation of success of the delivered patch as an ophthalmic light occlusive patch.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Isis Ghali whose telephone number is (703) 305-4048. The examiner can normally be reached on Monday-Friday from 7:00 to 5:30 Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Isis Ghali
Patent Examiner

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